

**O/294/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003430580 BY  
EKOTEX YOGA LTD  
TO REGISTER:**



**AS A TRADE MARK IN CLASS 27**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 417001 BY  
FLOORTEX EUROPE LIMITED**

## BACKGROUND AND PLEADINGS

1. On 28 March 2019, Ekotex Yoga Ltd (“the applicant”) applied to register the following trade mark in the UK:



2. The applicant initially sought registration for the following goods:

Class 18: Sports bag.

Class 28: Yoga mats; Sporting articles and equipment; Yoga blocks; Yoga straps.

3. Pending registration, the application was assigned the number 3387451 (“the 451 mark”). On 2 April 2019, the UK Trade Mark Examiner wrote to the applicant setting out that “Yoga mats” in the applicant’s specification was included in the wrong class. This Office requested that if the applicant wanted to amend the specification, it was to reply by 3 June 2019. On 10 April 2019, the applicant requested that the term “Yoga Mats” be removed from Class 28 and instead included in Class 27.
4. On 19 April 2019, the 451 mark was published for opposition purposes. On 17 July 2019, the application was opposed by Floortex Europe Limited (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
5. The opponent relies on the following trade mark:

ECOTEX

UK registration no. 2578810

Filing date 6 April 2011; registration date 6 January 2012

Relying on the following goods:

Class 27: Protective floor mats, in particular of plastic, stair protectors; all  
aforementioned products not made of textile materials.

("the opponent's mark")

6. The opposition was directed against the following goods within the 451 mark's specification only:

Class 27: Yoga mats.

7. In its Notice of Opposition, the opponent claims that there is a likelihood of confusion including a likelihood of association between the marks and, therefore, the application should be refused in respect of the opposed goods.
8. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its earlier mark.
9. On 16 September 2019, the applicant filed a Form TM12 to request that the 451 Mark be divided to enable the unopposed goods in Classes 18 and 28 to proceed to registration. As a result of this request, the 451 mark proceeded to registration while the application for protection of the following goods:

Class 27: Yoga mats.

would proceed under a separate registration, being UK application number 3430580 ("the applicant's mark"). The applicant's mark is shown on the front cover of this decision. Rule 28(3) of the Trade Marks Rules 2008 states:

"(3) Where the request to divide an application is sent after publication of the application, any objections in respect of, or opposition to, the original application shall be taken to apply to each divisional application and shall be proceeded with accordingly."

10. Consequently, the opposition that was initially directed at the 451 mark remained in place against the applicant's mark.

11. The opponent is represented by Brookes IP and the applicant is represented by Ancient Hume Limited. Both parties filed evidence. The opponent filed evidence in reply. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers. I note that some of the documents in these proceedings refer to the 451 mark as being the opposed mark, however, as a result of the division of the 451 mark, any reference to the 451 mark is taken as a reference to the applicant's mark.

## **EVIDENCE**

12. Both parties filed evidence in the form of witness statements. The opponent filed the witness statement of James Steven Bull dated 18 November 2019, which is accompanied by 6 exhibits. The applicant filed the witness statement of Abigail Rose Sweet dated 17 January 2020, which is accompanied by 2 exhibits. The opponent filed evidence in reply by way of a second witness statement of James Steven Bull dated 12 March 2020, which is accompanied by 2 exhibits. I have read the statements in their entirety and have summarised the most pertinent points below.

### The opponent's evidence

#### *The Witness Statement of James Steven Bull*

13. Mr Bull is the financial director of the opponent, a position he has held since 2010. The opponent has been established for over 18 years and specialises in the manufacture and supply of surface protection products for the office, industry and home. The opponent's ECOTEX range was commenced in 2009 and its use of the mark has continued since then. The ECOTEX range consists of chair mats that are made of a unique enhanced polymer and contain up to 50% recycled content,

are recyclable and made in a factory that obtains 25% of its energy from renewable sources.<sup>1</sup>

14. The opponent has submitted evidence that shows that it has used its mark on its website and has provided historic screen shots demonstrating its use on 2 June 2014, 25 August 2015, 28 August 2016, 16 July 2017, 9 June 2018 and 15 March 2019.<sup>2</sup>

15. Mr Bull has provided a copy of the opponent's 2014/2015 catalogue that shows the opponent's mark being advertised on a range of protective floor coverings for use with wheeled office chairs. Within the ECOTEX range, two types of products are described, being the 'revolutionmat' and 'evolutionmat'. Both are described as being ranges of chair mats. The catalogue explains that their chair mats include a range of protective floor coverings for many different types of floors, such as carpets and wood flooring.<sup>3</sup> In each image showing the opponent's goods, a wheeled office chair is shown placed on the mats.

16. Mr Bull states that goods bearing the opponent's mark are sold through a variety of retail outlets and approved stockists. A print out of the opponent's website dated 13 November 2019 shows 18 different stockists of FLOORTEX products across the UK and Ireland.<sup>4</sup> I note that the print out lists stockists of the opponent's FLOORTEX products only and does not contain any evidence that these retailers stock the goods bearing the opponent's mark. Further, the print-out from the opponent's website is dated after the relevant date. However, Mr Bull goes on to provide several copies of catalogues provided by the approved stockists<sup>5</sup> that range between the years 2014 and 2019. I note that the catalogues show various types of protective floor mats bearing the opponent's mark that come in a variety of sizes. Each example shows a wheeled office chair placed on the mat. I note that descriptions of the 'ECOTEX' range are included throughout the catalogues shown. For example, an excerpt from retailer Banner's 2015 catalogue describes 'ecotex

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<sup>1</sup> Exhibit JSB1

<sup>2</sup> Exhibit JSB3

<sup>3</sup> Exhibit JSB4

<sup>4</sup> Exhibit JSB5

<sup>5</sup> Ibid.

mats' as "a range of environmentally friendly chair mats designed for excellent performance and a reduced carbon footprint".<sup>6</sup> Additionally, the products bearing the opponent's mark are found within the 'chair mat' sections of the various catalogues.

17. The approximate annual turnover for goods bearing the opponent's mark between 2014 and 2019 have been provided and are as follows:

<b>Year</b>	<b>Approximate turnover (£)</b>
2014	26,600
2015	28,600
2016	54,500
2017	27,700
2018	18,200
2019	6,600

18. In addition to the annual turnover, Mr Bull has provided evidence of the approximate number of goods bearing the opponent's mark that were sold between 2014 and 2019. They are as follows:

<b>Year</b>	<b>Approximate sold</b>
2014	1,430
2015	1,900
2016	3,200
2017	1,600
2018	1,000
2019	400

19. Finally, Mr Bull has provided a selection of invoices that also span the years 2014 to 2019.<sup>7</sup> In respect of these invoices, I note the following:

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<sup>6</sup> Page 8 of Exhibit JSB5

<sup>7</sup> Exhibit JSB6

- a. The invoices include a large quantity of products that cover different ranges of products offered by the opponent, such as 'Doortex' and 'Cleartex', which make no reference to the mark relied upon in these proceedings. In total, 94 products that bear the opponent's mark are included within these invoices. This includes various types of chair mats of differing sizes, such as:
  - i. "Ecotex Rectangular Pc Enhanced Polymer Chair Mat for Low Pile Carpets"; and
  - ii. "Ecotex Evolutionmat Enhanced Polymer ChairMat f. HardFloors";
- b. The invoices confirm that the goods were to be delivered to a variety of locations across the UK including Milton Keynes, Windsor, Leicestershire, Telford, Middlesex, West Midlands, Dorset and Northampton;
- c. The invoices all bear the word FLOORTEX in the top right-hand corner, however, in the item description column, the opponent's mark is displayed on those products that are from the opponent's ECOTEX range;
- d. The recipients of the products included in the invoices have all been redacted by the opponent. It is, therefore, unclear whether these are items shipped to retailers or end users. The customer numbers and the opponent's VAT numbers have also been redacted by the opponent.
- e. The individual prices of the items have been redacted by the opponent, but the total amounts have not. Given that the invoices include products from other ranges offered by the opponent, it is unclear how much in sales the opponent has obtained in these invoices. However, the total amount of units sold under the ECOTEX brand is still visible. The opponent has not provided any explanation as to why this information has been redacted.

## The applicant's evidence

### *The Witness Statement of Abigail Rose Sweet*

20. Ms Sweet is the director of the applicant, a position she has held since the applicant's incorporation on 19 July 2017. Ms Sweet has been working in the yoga industry and practising yoga since at least June 2013.
21. The applicant's evidence sets out that yoga mats are specialist pieces of sports equipment that are designed to enhance the practitioner's experience, to keep them safe and prevent injury whilst practicing yoga. Ms Sweet explains that in order for a yoga mat to be comfortable and safe for the user, it provides additional grip, cushioning and a hygienic space for the user.
22. Ms Sweet has provided a history regarding the development of the yoga mat.<sup>8</sup> The article provided by Ms Sweet explains the origins of the yoga mat and details some issues a yoga practitioner would face if attempting to practice yoga on a hard flooring or a thin carpeted floor.
23. Ms Sweet explains the issues and risks involved with practising yoga without a mat. I will not reproduce those in full but have considered them fully. Ms Sweet provides an article from a website/online blog run by a yoga instructor who lists a summary of the 7 benefits of using a yoga mat to make practicing yoga more effective. The 7 benefits are to keep the practitioner's body warm, provide comfort, protect the practitioner from injury, improve balance, provide stability, make the space a sacred one and to give better grip.
24. Ms Sweet gives a list of criteria that, in her experience, users would consider when selecting a yoga mat. She then goes on to state that she considers it highly unlikely that a person wishing to purchase a yoga mat would visit an office furniture store or any of the stockists listed by the opponent in its evidence. Ms Sweet does, however, acknowledge that online retailer Amazon is the exception in that it sells a wide range of goods covering a variety of sectors and industries.

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<sup>8</sup> Exhibit ARS1



25. Finally, Ms Sweet confirms that the purpose of a yoga mat is to protect the user and enhance the experience of practicing yoga and not to protect the floor.

The opponent's evidence in reply

*The Second Witness Statement of James Steven Bull*

26. Within his second statement, Mr Bull accepts that a consumer wishing to purchase a yoga mat would either visit a specialised yoga centre or a more general sports and exercise shop. He also admits that a consumer would be unlikely to visit an office furniture or office supply company to purchase a yoga mat. Mr Bull provides a printout from Amazon.co.uk that lists a range of yoga mats for sale. He states that many consumers will simply type in the trade mark of a product in the search panel and that this will result in confusion between the marks. Mr Bull then states that a consumer may type ECOTEX into an Amazon search and the result could include goods bearing the applicant's mark. I note Mr Bull's comments, however, no evidence of this is provided.

27. Further, Mr Bull provides a printout of a result of a search on Amazon.co.uk for 'ECOTEX MATS'. While the applicant's goods are not listed, another brand of yoga mat is included. I note Mr Bull's comments on this point, however, no evidence is provided that goods bearing the applicant's mark would show up on a search for the opponent's goods.

28. Additionally, the evidence provided is undated. However, from the delivery options that are shown as available I note that some items listed are available for delivery by the next day, being 6 March. It may be that these print outs were taken on 5 March 2020 and are, therefore, are dated after the relevant period. However, if this is not the case, as no year is provided this evidence will not be considered.

**DECISION**

29. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark.”

30. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

31. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

32. The mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

### **Proof of use**

33. As noted above, the applicant has put the opponent to proof of use of its mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the

United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

34. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

35. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the 5-year period ending with the date of the application in issue i.e. 29 March 2014 to 28 March 2019.

36. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

37. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

### Form of the Mark

38. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article

15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)"

39. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:



"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

40. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

41. Throughout its evidence, the opponent has used the earlier mark as registered, as well as the following signs:



and



42. I note that the opponent's mark is a word only mark and can be used in any standard typeface and registration in black and white will cover the use of the mark in different colours. I do not, therefore, consider that use of the mark in question is not use of the mark as registered merely because it has been presented in a stylised font and in different colours. However, the stylisation used in this case means that the fourth letter of the opponent's mark, being the letter T, has been altered. It is my view that the alteration to the fourth character of the mark shown in a) above has resulted in the appearance of a stylised number '1' or '7', meaning that the word may be seen as 'ECO1EX' or 'ECO7EX'. As a result, mark a) is not use of the opponent's mark as registered. I must, therefore, consider whether this is an acceptable variant use of the mark under section 6A(4)(a) of the Act.

43. As per the case of *Nirvana* (cited above), it is now necessary to determine whether the differences between the opponent's mark and mark a) alter the opponent's mark's distinctive character. Given that the opponent's mark is a word only mark, the distinctive character of the mark lies in the word itself. As noted above, the differences between the marks are the use of stylised text (which results in the alteration of the fourth character of the mark) and the use of colour. For the same reasons set out above, I do not consider that the use of stylisation and colour per se alters the distinctive character of the mark. However, in this case, as the stylisation results in the change to the letter 'T' (meaning it may be seen as either a 7 or a 1), I am of the view that the word displayed in mark a) is ambiguous and, therefore, alters the distinctive character of the opponent's mark. The use of mark a) is, therefore, not an acceptable variant of the opponent's mark.

44. The stylisation of the word 'ECOTEX' within mark b) is identical to the first variant mark. The only difference in the presentation of the mark are that the letters 'E-C-O' are presented in black, not white and the words "a floortex brand" appear beneath the word 'ECOTEX'. The use of the mark with the addition of the words "a floortex brand" would be use in combination with additional matter and acceptable within the *Colloseum* test. However, given that the alteration to the letter 'T' is the same as mark a), I find that mark b) is not an acceptable variant of the opponent's mark.

45. The use of the marks a) and b) contained within the opponent's evidence will not be considered for the purpose of proof of use. However, the evidence provided also contains use of the word as registered (in all capitals) and presented as 'Ecotex'. The presentation as 'Ecotex' falls within the notional and fair use of the opponent's mark and will be considered for the purpose of my assessment of proof of use.

### Sufficient Use

46. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>9</sup>

47. It is clear from the evidence provided that the opponent's goods sold under the ECOTEX brand have been marketed since 2014 on the opponent's own website<sup>10</sup>, within its own catalogues<sup>11</sup> and within various retailers' catalogues.<sup>12</sup>

48. Firstly, I do not consider that the market for protective floor mats not made of textiles for use with office chairs to be particularly large. The opponent has provided evidence between the years of 2014 and 2019 regarding the turnover and sales of its products under the ECOTEX brand. As set out above, the relevant period for proof of use runs from 29 March 2014 to 28 March 2019. Some of the figures provided will, therefore, fall outside the relevant period. However, the evidence is such that I am content to conclude that even if the figures from 2014 and 2019 are reduced appropriately, the figures provided are still significant enough to show a market share for the relevant goods. Further, the opponent has also provided evidence by way of invoices that demonstrate the sale of 94 products within the ECOTEX range that fall within the relevant period. Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use of the opponent's mark during the relevant period.

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<sup>9</sup> New York SHK Jeans GmbH & Co KG v OHIM, T-415/09

<sup>10</sup> Exhibit JSB3

<sup>11</sup> Exhibit JSB4

<sup>12</sup> Exhibit JSB5

## Fair Specification

49. I must now consider whether, or the extent to which, the evidence shows use of the opponent's mark in relation to the goods relied upon.

50. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

51. The goods covered by the opponent’s mark’s specification are “protective floor mats, in particular of plastic, stair protectors; all aforementioned products not made of textile materials”. In order to make my assessment on fair specification, it is necessary to determine what goods are covered by the opponent’s mark’s specification. The term ‘in particular’ is used to indicate what is being said applies especially to one thing.<sup>13</sup> Its use in a trade mark specification isn’t, therefore, to expressly state the type of goods or services being relied upon but, instead, to demonstrate a focus on one good/service over others. Therefore, the use of ‘in particular’ in the opponent’s mark isn’t to say that the opponent will *only* use the mark on plastic stair protectors and as a result, its use doesn’t prevent the opponent from relying on the mark for other types of protective floor mats.

52. However, the use for which the opponent has provided evidence demonstrates use of the opponent’s mark in relation to protective floor mats for use with wheeled office chairs only. In this case, I consider it appropriate to identify a subcategory of goods on which the opponent can rely for the purpose of this opposition. I consider that “protective floor mats, in particular of plastic, stair protectors; all aforementioned products not made of textile materials” is a broad specification of goods and can cover all sorts of protective floor mats. I do not consider that the average consumer would consider a plastic stair protector and a protective mat for use with a wheeled office chair as goods that fall within the same category, despite

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<sup>13</sup> <https://www.collinsdictionary.com/dictionary/english/in-particular>

sharing the same purpose of protecting a surface. Therefore, given that genuine use has only been proven for protective floor mats for use with wheeled office chairs, it is necessary to limit the scope of the opponent's opposition. For the purpose of fair specification, I note that some office chairs come without wheels and, therefore, limit the opponent's specification to "protective floor mats not made of textiles for use with office chairs".

### **Section 5(2) - case law**

53. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

54. In light of my finding above, the competing goods are as follows:

The opponent's goods	The applicant's goods
<u>Class 27</u>  Protective floor mats not made of textiles for use with office chairs	<u>Class 27</u>  Yoga mats.

55. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

56. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;



- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

57. The opponent submits that,

“c) It is submitted that one of the purposes of the Opponent’s goods is to protect flooring surfaces, whether they be hard surfaces or carpeted surfaces. The main purpose of the goods is protection of the flooring.

d) Another function of the Opponent’s goods is to prevent furniture, particularly chairs, from slipping, and potentially causing injury to the user of the furniture.

e) The Applicants allege that yoga mats are “specialist pieces of sports equipment.... designed to enhance the practitioner’s experience and to keep the participant safe and prevent injury whilst engaged in the practice of yoga”.

However, it seems clear that while the safety of the user while using a yoga mat is one of the purposes of the mat, another purpose is to protect the floor surface on which the yoga is being performed.

g) Therefore, we submit that the Applicant’s goods “yoga mats” share two of the functions of the Opponent’s protective floor mats, namely to protect the floor and to protect the user of the goods from injury.

h) As such, the goods applied for are clearly similar in nature and purpose to the goods covered by the Opponent’s earlier registration, and for which proof of use has been provided.”

58. The evidence from the applicant, that I have summarised above, seeks to provide evidence of the purpose of a yoga mat. Further, the applicant has provided lengthy

submissions in respect of the goods comparison. While I do not propose to reproduce them in full here, I will summarise them briefly.

59. The applicant submits that the nature, purpose and method of use of the goods offered by the parties' respective marks are different. The applicant also submits that there is no competitive or complementary relationship between the goods and that the distribution channels of the goods are different.

60. Further, the applicant submits that,

“taking all factors into account, the goods are manifestly different. Indeed, Mr Bull concedes at paragraph 7 of his Second Witness Statement that none of the applicant's products were identified in the results of a search on the Amazon platform for Ecotex.”

61. I note the applicant's submissions on this point and note that at paragraph 7 of the second witness statement of Mr James Steven Bull wherein the search was for 'ECOTEX MATS', not 'Ecotex' as stated by the applicant.

62. “Yoga mats” within the applicant's specification describes a mat that is used for the purpose of practicing yoga. I note that applicant's evidence and both parties' submissions regarding the purpose of a yoga mat. I agree with the applicant in that a yoga mat is used to provide comfort for the user, to protect the user from injury and to provide an effective surface on which to perform yoga. I disagree with the opponent's submissions that a yoga mat is used to protect the floor.

63. “Protective floor mats not made of textiles for use with office chairs” as contained within the opponent's mark describes a type of protective mat that is placed on the floor and upon which, an office chair is placed. The main purpose of these mats is to protect the floor upon which the office chair sits. I do not consider the protective floor mats offer any additional safety to the user as, in my view, a user is just as likely (or unlikely) to cause an injury to themselves whether there is a protective floor mat or not.

64. The goods in the parties' respective specifications are not identical, however, it is necessary to consider whether they are similar and if so, to what extent.
65. The purpose of a yoga mat is to lay it on the floor so that the user may practise yoga on it. I am of the view that the purpose of a yoga mat is not to protect the flooring but to enhance the user's experience and to provide additional safety for the user, especially on hard floors that are likely to be slippery. The purpose of a protective floor mat for use with office chairs is to protect the floor for various reasons. Office chairs can be heavy and can cause indentations to carpeted flooring and cause scrapes to hard flooring. Therefore, the purpose of a protective floor mat for office chairs is to protect the floor from damage from the office chair. I find that there is no overlap in purpose between the goods. However, if there is any overlap it is likely to be very minimal.
66. The user of a yoga mat will be someone who is practising the art of yoga. The user of a protective floor mat for use with an office chair will be someone who is likely sat at an office or home desk. The users of the goods will not directly overlap; however, I acknowledge that there may be overlap to the extent that they can both be used by members of the general public.
67. The physical nature of a yoga mat will be that it is rolled out onto the floor. The physical nature of protective floor mat for use with office chair will be that it is placed on the floor. Therefore, there will be an overlap in nature in that both goods are thin pieces of material that are placed on the floor.
68. There is no close connection between the goods in that a yoga mat and a protective floor mat for use with an office chair would not be indispensable or important to one another.<sup>14</sup> Therefore, there is no complementary relationship between the goods. Neither would one see a competitive relationship between the goods in that a consumer would not choose to purchase one over the other.
69. There is no obvious overlap in trade channels, in that a yoga mat will commonly be purchased from a yoga specialist or a sports goods store and a protective floor mat

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<sup>14</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

for use with office chairs will commonly be purchased from an office furniture supply store. I recognise that it is the opponent's submissions that both items can be purchased from mass retailers and therefore, there may be an overlap in trade channels. However, even if that is the case, the goods will be found within different sections or departments of those retailers. The fact that goods may all be available from general retailers does is not enough for them to be considered similar.

70. I recognise that all of the goods may be used by members of the general public, but this is not enough on its own for a finding of similarity. Further, the fact that goods may be sold through the same generic retailers also does not assist the opponent. That leaves only an overlap in nature. As noted above, I do not consider there to be any overlap in use but, even if I am wrong in that finding, the overlap will be very minimal. Taking all of this into account, I find that "yoga mats" contained in the applicant's specification and "protective floor mats not made of textiles for use with office chairs" in the opponent's specification are similar to no more than a very low degree.

### **The average consumer and the nature of the purchasing act**

71. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

72. The opponent submits that:

“the average consumer of both the Opponent’s goods and the Applicant’s goods is likely to be a member of the general public. Neither the Opponent’s goods or the Applicant’s goods can be described as highly specialist items, and both types of goods are relatively inexpensive. Although the Opponent supplies quantities of its goods to businesses for use in office environments, it also sells its goods through mass market retailers such as Amazon and Argos to individuals for use in the home, and therefore the consumer of both the Applicant’s goods and the Opponent’s goods can be said to be members of the general public.”

73. The applicant submits that:

#### **7.2 The Opponent's Goods - Average Consumer**

The average consumer for the opponent's goods is likely to be a buyer or purchasing executive, or the like. In **Exhibit JSB6**, many of the invoices which have been submitted show multiple chair mats being purchased as part of the same order. This suggests that the purchases are made on a commercial or industrial scale. As a business user, it is likely that the average consumer will pay at least an average/higher than average degree of attention when considering a purchase of chair mats for his/her company. It is clear from **Exhibit JSB5** to the Witness Statement of James S Bull of 18 November 2019 that many stockists of the opponent's chair mats have retail stores and/or online retail operations. The visual differences in the relevant marks is, therefore, an important factor in any comparison.

#### **7.3 The Applicant's Goods -Average Consumer**

The average consumer for the applicant's goods is likely to be a member of the general public. The practice of yoga is accessible to most people. The degree of attention paid is likely to be at least average/higher than average as this is a personal item which will play an important role in their practice of yoga.

#### **7.4 Different Consumers**

The goods are different. Accordingly, it is not surprising that the 'average consumer' for the respective goods also differs. For different reasons, the degree of attention paid in the purchasing act, is likely to be at least average/higher than average.”

74. For the most part, the average consumer for the opponent's goods will be businesses seeking to purchase furniture for their offices. While wheeled office chairs will be mostly be used in offices, it is not uncommon for them to be used at home for various reasons. I am, therefore, of the view that the average consumer for the opponent's goods will be both business users and members of the general public.

75. Yoga is a widely practised physical activity undertaken by many members of the general public. In addition, businesses such as yoga centres and other leisure centres will also purchase yoga mats for use by their members. Therefore, I find that the average consumer for the goods in the applicant's specification will be both business users and members of the general public.

76. The opponent's goods are likely to be sold by a range of retailers including office furniture stores, online retailers and direct from the opponent itself. The applicant's goods are most likely to be sold by yoga specialists, sporting goods retailers and online retailers.

77. For all goods within the parties' specification, they will likely be displayed on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites and catalogues, where the consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. The selection of goods will, therefore, be primarily visual. While the visual aspect plays a greater role in the selection process, I do not discount aural consideration in the form of advice sought from sales assistants, word of mouth recommendations or telephone queries with retailers.

78. The price of the goods at issue may vary depending on a number of factors, such as size and materials used, but is likely to be relatively low. The goods covered by the parties' specifications will likely be purchased infrequently in that the goods are meant to be long lasting and durable. For the opponent's goods, the average consumer may consider a number of factors such as materials used, colour, size and durability. For the applicant's goods, the average consumer will consider the materials used, colour or pattern, size, thickness, texture and level of grip. With these factors in mind, I consider that the average consumer for the parties' respective goods will pay a medium degree of attention during the purchasing process.

### **Distinctive character of the opponent's mark**

79. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and

statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

80. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, the opponent has not pleaded that its mark has acquired enhanced distinctiveness through use. In any event, I do not consider the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness because the opponent has failed to provide evidence of the market share held by its mark in the UK. Further, the invoices provided do not demonstrate a significant level of sales of the opponent’s goods within the UK. Consequently, I have only the inherent position to consider.

81. The opponent’s mark is made up of one element, being the invented word ‘ECOTEX’. When something is described as being ‘eco’, it is commonly associated with being a product that is ‘eco-friendly’, meaning that it is friendly to the environment. I find that a significant proportion of average consumers would consider the first part of the word, being ‘ECO’ as a reference to eco-friendly products.

82. While the letters ‘T-E-X’ would have no obvious meaning, for the reasons set out above, I find that the word ‘ECOTEX’ may be allusive to the fact that the goods offered by the opponent are eco-friendly. Overall, I consider that the opponent’s mark has at least a medium degree of inherent distinctive character.

### **Comparison of marks**

83. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the




overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

84. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

85. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

86. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
ECOTEX	

87. The opponent submits that:

“a) The Applicant's mark in issue is for a figurative mark incorporating the distinctive word EKOTEX, the purely descriptive word YOGA and a design element consisting of three red lines.

b) When comparing the mark applied for with the earlier mark, it is clear that the marks to be compared are the words EKOTEX being the dominant and only distinctive element of the mark applied for, and ECOTEX being the Opponent's earlier registration.

c) The words EKOTEX and ECOTEX are only one letter different, and are phonetically identical. As such, it is submitted that the marks are confusingly similar by virtue of the visual and aural identity and similarity of the EKOTEX/ECOTEX elements and the established fact that consumers pay most attention to words included in figurative marks consisting of words and devices.

d) As such, when encountering the Applicant's Trade Mark EKOTEX YOGA & device, the average consumer will make an association between that mark and the Opponent's earlier ECOTEX mark. There therefore exists a likelihood of confusion between the marks including a likelihood of association."

88. The applicant submits that:

"The applicant's mark is a complex composite mark which includes three distinctively presented horizontal red lines, as well as the words EKOTEX YOGA. No element is more dominant or distinctive than any other. See paragraph 3 above (Case Law - Section 5(2)(b)). It is important to consider the mark as a whole. It is visually quite different from ECO TEX.

The average consumer will pay at least equal attention to the figurative element as to the words by virtue of the size and prominence of the figurative elements of the mark applied for. There are noticeable and significant differences between the marks, which allow the marks to be readily distinguished. There is neither a likelihood of consumer confusion nor a likelihood of association between the applicant's and opponent's marks."

## Overall Impression

### *The applicant's mark*

89. The applicant's mark consists of two elements, being a word element and a device element. The word element consists of the words 'EKOTEX YOGA'. The word 'EKOTEX' is displayed in black and placed above the word 'YOGA', which is displayed in pink. The word 'EKOTEX' will be seen by a significant proportion of the average consumer to be a made-up word with no particular meaning. The word 'YOGA' is allusive to the type of goods for which the applicant seeks protection.

90. The device element of the applicant's mark is three pink horizontal lines that are placed above the word 'EKOTEX'. While the device element is noticeable, in my view that the eye is naturally drawn to the elements of the mark that can be read. I consider the word 'EKOTEX' to play the greater role in the overall impression of the mark, with the word 'YOGA' and the device element playing a lesser role.

### *The opponent's mark*

91. The opponent's mark consists of the word 'ECOTEX'. There are no other elements to contribute to the overall impression, which lies in the word itself.

## Visual Comparison

92. Visually, the marks coincide in the words 'ECOTEX' and 'EKOTEX' which, save for the difference in the second letter, are identical. The marks also differ in the word 'YOGA', that is present in the applicant's mark but absent in the opponent's mark. The marks also differ in that the applicant's mark has a device element, being three horizontal lines that sit above the word 'EKOTEX'. While I have found that the device element and the word 'YOGA' play a lesser role in the applicant's mark, they still constitute a visual difference between the marks. I note that the opponent's mark is a word only mark and can be used in any standard typeface and registration in black and white will cover the use of the mark in different colours.

Taking all of this into account, I find that the marks are visually similar to a medium degree.

### Aural Comparison

93. Aurally, the applicant's mark consists of five syllables. While I do not discount the fact that some consumers may pronounce the applicant's mark 'ECK-OH-TEKS-YO-GAH', I find that a significant proportion of average consumers will pronounce the applicant's mark as 'EEK-OH-TEKS-YO-GAH'. The opponent's mark consists of three syllables, being 'EEK-OH-TEKS'. The device element of the applicant's mark will not be pronounced. The similarities, therefore, include the entirety of the aural element of the opponent's mark. The marks differ aurally with the inclusion of the last two syllables of the opponent's mark. Given that the word 'YOGA' would be considered descriptive of the type of goods for which the applicant seeks registration, I conclude that it is unlikely to be pronounced. In those circumstances, the marks will be aurally identical. However, if the word 'YOGA' is pronounced, then the marks will be aurally similar to at least a medium degree.

### Conceptual Comparison

94. The only element of the applicant's mark that might convey a conceptual message is the word element, being 'EKOTEX YOGA'. The average consumer will view the word 'ECOTEX' in the opponent's mark as possibly describing a product that is eco-friendly. I do not find that the average consumer would make that connection in respect of the applicant's mark as I do not consider the use of a 'K' to be a common misspelling of the word 'eco'. 'ECOTEX' and 'EKOTEX' will, therefore, be conceptually dissimilar. The word 'YOGA' will be linked to the physical activity of yoga and will act as a further point of conceptual difference between the marks. Overall, I find that the conceptual meaning conveyed by the marks as a whole is dissimilar.

95. If I am wrong in my finding that the average consumer would not connect the 'EKOTEX' to eco-friendly products, I find that the use of the letter 'K' will be seen as a misspelling of 'eco' and, therefore, be conceptually similar to the word

'ECOTEX' in the opponent's mark. However, the word 'YOGA' will remain a point of conceptual difference between the two. Overall, I find that the conceptual meaning conveyed by the marks as a whole will be similar to at least a medium degree.

### **Likelihood of confusion**

96. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

97. I have found the goods to be similar to no more than a very low degree. I have found the average consumer for both parties' goods to be a member of the general public and business users. The goods will be purchased primarily by visual means, although I do not discount an aural component. I have concluded that a medium degree of attention is likely to be paid in the purchasing process. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

### **Direct Confusion**

98. I have found the marks to be visually similar to a medium degree, aurally identical or similar to at least a medium degree (depending on whether the word 'YOGA' is

pronounced) and conceptually dissimilar or similar to at least a medium degree (depending on whether the letters 'EKO' in the applicant's mark will be considered a misspelling of 'eco'). The opponent's mark has at least a medium degree of inherent distinctive character. Notwithstanding the principle of imperfect recollection and taking all of the above factors into account, I consider that the presence of the word 'YOGA' and/or the device element in the applicant's mark will be sufficient to enable the consumer to differentiate between the marks. This will particularly be the case given the importance of the visual component in the selection of the goods at issue and in circumstances in which the consumer will be paying a medium degree of attention when selecting the goods at issue. Consequently, I do not consider there to be a likelihood of direct confusion between the marks, especially given that they will be used on goods that are only similar to a very low degree.

#### Indirect Confusion

99. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

100. I must now consider the possibility of indirect confusion and whether average consumers would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of the shared common elements of the marks.

101. In the case of *Canon* (cited above), the CJEU stated that a lesser degree of similarity between the goods or services of marks may be offset by the greater degree of similarity between the marks, and vice versa. Whilst I have found that the marks are similar to varying degrees, I do not consider these similarities great enough to overcome the fact that the goods are similar to no more than a very low degree. This is particularly the case given that the visual component will play a greater role in the selection process of the goods at issue, meaning that the visual differences between the marks will not be overlooked. I am of the view that average consumers are more likely to consider the similarities between the marks to be a coincidence when used on goods sharing such a low degree of similarity, rather than the marks originating from the same undertaking. For these reasons, I conclude that there is no likelihood of indirect confusion between the marks.

## **CONCLUSION**

102. The opposition fails in its entirety and the applicant's mark can proceed to registration.

## **COSTS**

103. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,000** as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the opponent's  
statement:

£200

Preparing evidence and considering the opponent's evidence:	£500
Preparing written submissions in lieu of a hearing:	£300
<b>Total</b>	<b>£1,000</b>

104. I therefore order Floortex Europe Limited to pay Ekotex Yoga Ltd the sum of £1,000. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28<sup>th</sup> day of May 2020**

**A COOPER**  
**For the Registrar**